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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/441,443	05/15/1995	MICHAEL HOUGHTON	0063.024	1917
25226	7590	01/13/2006		
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			EXAMINER ZEMAN, MARY K	
			ART UNIT	PAPER NUMBER

1631

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/441,443

Applicant(s)

HOUGHTON ET AL.

Examiner

Mary K. Zeman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 341-349, 351, 352, 354, 355, 357, 358, 360-366, 368-369, 371-372, 374-469 is/are allowed.
- 6) ☒ Claim(s) 60-73, 76-78, 81-83, 86-88, 91-93, 96-98, 101-103, 106-108, 111-113, 116-118, 121-123, 126-128, 131-133, 136-138, 141-143, 146-148, 151-153, 156-158, 161-163, 166-168, 171-173, 176-178, 181-183, 186-188, 191-193, 196-198, 201-203, 206-208, 211-213, 216-218, 221-223, 226-228, 231-233, 236-238, 241-243, 246-248, 250-252, 255-257, 260-262, 265-268, 271-273, 276-278, 281-284, 287-289, 292-294, 297-299, 302-304, 307-309, 312-314, 317-319, 322-324, 327-329, 332-340 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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PTOL-326 (Rev. 7-05)

**Office Action Summary**

Part of Paper No./Mail Date 20060106

Continuation of Disposition of Claims: Claims pending in the application are 60-73, 76-78, 81-83, 86-88, 91-93, 96-98, 101-103, 106-108, 111-113, 116-118, 121-123, 126-128, 131-133, 136-138, 141-143, 146-148, 151-153, 156-158, 161-163, 166-168, 171-173, 176-178, 181-183, 186-188, 191-193, 196-198, 201-203, 206-208, 211-213, 216-218, 221-223, 226-228, 231-233, 236-238, 241-243, 246-248, 250-252, 255-257 260-262, 265-268, 271-273, 276-278, 281-284, 287-289, 292-294, 297-299, 302-304, 307-309, 312-314, 317-319, 322-324, 327-329, 332-340; 341-349, 351, 352, 354, 355, 357, 358, 360-366, 368-369, 371-372, 374-469.

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### **DETAILED ACTION**

The amendment and arguments filed 11/4/05 have been entered and considered.

Applicant's arguments with respect to claims 60-73, 76-78, 81-83, 86-88, 91-93, 96-98, 101-103, 106-108, 111-113, 116-118, 121-123, 126-128, 131-133, 136-138, 141-143, 146-148, 151-153, 156-158, 161-163, 166-168, 171-173, 176-178, 181-183, 186-188, 191-193, 196-198, 201-203, 206-208, 211-213, 216-218, 221-223, 226-228, 231-233, 236-238, 241-243, 246-248, 250-252, 255-257 260-262, 265-268, 271-273, 276-278, 281-284, 287-289, 292-294, 297-299, 302-304, 307-309, 312-314, 317-319, 322-324, 327-329, 332-340; 341-349, 351, 352, 354, 355, 357, 358, 360-366, 368-369, 371-372, 374-469 are have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 60-73, 76-78, 81-83, 86-88, 91-93, 96-98, 101-103, 106-108, 111-113, 116-118, 121-123, 126-128, 131-133, 136-138, 141-143, 146-148, 151-153, 156-158, 161-163, 166-168, 171-173, 176-178, 181-183, 186-188, 191-193, 196-198, 201-203, 206-208, 211-213, 216-218, 221-223, 226-228, 231-233, 236-238, 241-243, 246-248, 250-252, 255-257 260-262, 265-268, 271-273, 276-278, 281-284, 287-289, 292-294, 297-299, 302-304, 307-309, 312-314, 317-319, 322-324, 327-329, 332-340 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The independent claims have each been amended to recite polynucleotides of at least 12 contiguous nucleotides, and less than some arbitrary length. The specification, as filed, lacks basis for this limitation. The specification sets forth several potential definitions for polynucleotides falling within the scope of the invention. Page 26: "a polynucleotide "derived

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from” a designated sequence refers to a polynucleotide sequence which is comprised of a sequence of approximately ... at least about 10-12...” This is not support for at least 12, but less than 353 as recited in claim 60.

Page 61: “sequences of 10-12 nucleotides are preferred...” this is not support for the genus of at least 12, but less than 353, as recited in claim 60.

Page 69 discusses labeled probes for cloning as “approximately 8 or more and preferably 20 or more nucleotides”. This is not support for the genus of at least 12 contiguous nucleotides but less than 353 as claimed in claim 60.

Sections IV.A. 5-23, 27, 30 etc. each disclose probes of approximately 30 nucleotides in length. This is not support for the genus of at least 12 contiguous nucleotides but less than 353 as claimed in claim 60.

Sections IV.A. 24, 25 and 28 etc. each disclose probes of 15 or 20 nucleotides in length. This is not support for the genus of at least 12 contiguous nucleotides but less than 353 as claimed in claim 60.

Therefore, the limitation of “at least 12 contiguous nucleotides... wherein said polynucleotide has a maximum length of XXX” is new matter not supported by the specification as filed.

### ***Conclusion***

Claims 341-349, 351, 352, 354, 355, 357, 358, 360-366, 368-369, 371-372, 374-469 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

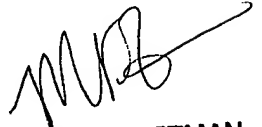
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, PhD can be reached on (571) 272 0718. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
MARY K. ZEMAN  
PRIMARY EXAMINER  
AW/631  
1/6/06